

REMARKS

Claims 22-70 are pending in the Application and all were rejected in the final Office action mailed April 14, 2010. The Advisory Action of August 31, 2010 did not enter the amendments set forth in the response filed June 14, 2010. Claims 22, 37, 42, 49, and 56 are amended and new claims 71-104 are added by this response. Claims 22, 37, 49, and 56 are independent claims. Claims 23-36 and 79-87, claims 38-48 and 88-94, claims 50-55 and 95-103, and claims 57-78 and 104 depend, respectively, from claims 22, 37, 49, and 56. Applicants respectfully request reconsideration of pending claims 22-70, and consideration of new claims 71-104, in view of the remarks set forth below.

Amendments to the Specification

The section titled "CROSS REFERENCE TO RELATED APPLICATIONS" that begins on page 1 of the Application has been updated. Applicants respectfully submit that these amendments do not add new matter.

Amendments to the Claims

Claims 22, 37, 49, and 56 have been amended to correct an antecedent issue and to clarify aspects of the claimed subject matter. Applicants respectfully submit that support for the amendments to claims 22, 37, 42, 49, and 56 may be found, for example, at pages 158, 194-195, 216, 218, 234-236, 239-241, 243-245, and 259-261, and at FIGs. 28a, 29a, 29b, 31, 46b, 49a, 49b, 49c, 55a, and 60 of the Application. Applicants respectfully submit that these amendments do not add new matter, and that new claims 71-103 are allowable for at least the same reasons set forth above with respect to the rejections of independent claims 22, 37, 42, 49, and 56. Applicants respectfully submit that these amendments do not add new matter.

Claim Rejections

Claims 22-70 were rejected under 35 U.S.C. §103(a) as being unpatentable over Meyerson, *et al.* (US 5,579,487, hereinafter "Meyerson") in view of Morris, *et al.* (US 4,884,132, hereinafter "Morris"), in further view of Kotani (US 4,847,891). Applicants respectfully traverse the rejection.

Applicants respectfully note that all claims are rejected for reasons of obviousness. Applicants first review the requirements for a rejection based on obviousness. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

As noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." (emphasis added) See MPEP at 2143.03. Further, "[all] words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." (emphasis added) *Id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

Applicants respectfully traverse the rejections. Notwithstanding, Applicants have amended claims 22-70 as shown above. Applicants respectfully submit that the amendments render the rejections of the Office action of April 14, 2010 moot.

With regards to independent claim 22, Applicants respectfully submit that claim 22 has been amended so that it now recites, “[a] handheld device for communicating an image via a communication network, the device comprising an imaging device for capturing an image as image data; processing circuitry for processing the image data; a wireless communication interface for transmitting the processed image data; a display device for providing feedback to a user; and wherein a communication path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein a first communication path is selected when the type of data is processed image data and a second communication path is selected when the type of data is speech data.” Claims 37, 49, and 56 now recite similar features. Applicants respectfully submit that the cited art does not teach, suggest, or disclose all aspects of claim 22.

Applicants respectfully submit that the cited art does not teach, suggest, or disclose, at least, “wherein a communication path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein a first communication path is selected when the type of data is processed image data and a second communication path is selected when the type of data is speech data.” Applicants appreciate recognition by the Office that Meyerson does not disclose “a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated wherein the type

of data is one or both of processed image data/or speech data." See Office action of April 14, 2010 at pages 3-4.

The Office, however, then turns to Morris, and asserts that Morris teaches "an image being processed and transmitted over a cellular network (column 1, lines 35-39); and selecting a path automatically to be used by the device to wirelessly communicate the image data (column 1, lines 35-68, processed image data and/or speech data are transmitted wirelessly)." See Office action of April 14, 2010 at page 3. Applicants respectfully note, however, that the cited portions of Morris do not teach, suggest, or disclose "automatically selecting from a plurality of communication paths," let alone selecting "based upon a type of data being communicated," in accordance with claim 22, and therefore does not teach, suggest, or disclose "a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated," as asserted by the Office. This is true for a number of reasons. Applicants respectfully submit that Morris specifically teaches transmission of "time, picture of the suspect, and identification of the victim" and "audio pickup at the portable unit" to a single remote receiver via a single call using a cellular network. See *id.* at col. 1, lines 20-43. Therefore, Applicants respectfully submit that Morris teaches only a single path. In addition, Applicants respectfully submit that Morris does not teach "selection," in that "to select" may be defined as "to choose in preference to another or other; pick out." See "select." Dictionary.com Unabridged. Random House, Inc. 13 Oct. 2010. <Dictionary.com <http://dictionary.reference.com/browse/select>>. Applicants respectfully submit that because Morris fails to teach any other alternative or "others," Morris fails to teach selection. Therefore, Applicants respectfully submit that the proposed combination of Meyerson and Morris do not teach, suggest, or disclose "a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated," as asserted by the Office, for at least these reasons. It necessarily follows, therefore, that the proposed combination of Meyerson and Morris does not teach, suggest, or disclose "wherein a communication

path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated," as claimed.

The Office seemingly admits the shortcomings of Meyerson and Morris when it introduces Kotani, stating at page 3 of the Office action, "Kotani teaches selecting a path from a plurality of communication paths based upon a type of data being communicated wherein the type of data is one or both of processed [sic, "image"] data an/or speed [sic, "speech"] data (Fig. 3A, "image transmission" for transmitting image data; FIG. 3B, "voice message output" for transmitting speed [sic, "speech"] data)." Applicants respectfully disagree. Applicants respectfully submit that Kotani does not teach transmission of speech data. Instead, Kotani teaches transmission of analog speech signals. Although Kotani teaches storage of voice after conversion to digital form, Kotani clearly describes transmission of a voice message, not data. See *id.* at col. 2, line 61 to col. 3, line 2 and col. 3, lines 53-67. Therefore, Applicants respectfully submit that Kotani does not "a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated," as asserted by the Office, and therefore Kotani does not remedy the admitted shortcomings of Meyerson and Morris, for at least the reasons set forth above. Applicants respectfully submits that for at least the reasons discussed above, the proposed combination of Meyerson, Morris, and Kotani does not teach, suggest, or disclose all aspects of Applicants' claim 22, that a *prima facie* case of obviousness has not been established, as required by M.P.E.P. §2142, and that claim 22 is allowable over the cited art for at least these reasons. Because claims 23-36 and 79-87 depend from claim 22, Applicants respectfully submit that those claims are also allowable.

With regard to independent claims 37, 49, and 56, Applicants respectfully submit that claims 37, 49, and 56 were rejected over the same art using the same rationale set forth in the rejection of claim 22, that claims 37, 49, and 56 have been amended to recite language similar to claim 22, and that claims 37, 49, and 56, and

therefore their respective dependent claim are allowable for at least some of the reasons set forth above.

Based at least upon the above, Applicants respectfully submit that the proposed combination of Meyerson, Morris, and Kotani does not teach, suggest, or disclose all aspects of Applicants' claims 22, 37, 49, and 56, as required by M.P.E.P. §2142 and §2143.03, that a *prima facie* case of obviousness is not supported by the cited references, that the cited art does not render claims 22, 37, 49, and 56 unpatentable, and that claims 22, 36, 49, and 56, and any claims that depend therefrom, are allowable over the proposed combination of Meyerson, Morris, and Kotani. Applicants respectfully submit that claims that depend from claims 22, 37, 49, and 56 are allowable over the cited art for additional reasons.

With regard to claims 36 and 70, the Office again asserts that Meyerson discloses "...that a character recognition process (column 9, line 28, a bar code scanner does character recognition)." See Office action of April 14, 2010 at page 6 and Office action of October 5, 2009 at page 6. Applicants have previously addressed this rejection. See Response filed January 5, 2010 at page 26 and Response filed November 5, 2008 at pages 23-24. Applicants again respectfully disagree with the assertion of the Office, and respectfully maintain that the Office has failed to show any basis for the conclusory statement that "...a bar code scanner does character recognition." Applicants respectfully submit that this statement by the Office, without support of any kind, may be perceived as an assertion of Official Notice, or an assertion by the Office that it is inherent that a bar code scanner recognizes characters.

In responding to Applicants' arguments, the instant Office action states the following, at page 9:

With regard to claims 36 and 70, Applicants argue that the Office action has failed to show any basis for the consolatory statement that "a bar code scanner does character recognition." Examiner respectfully notes that the functionalities of a bar code scanner, as well known in the art, include recognizing bar codes.

Applicants do not dispute that the functionality of a “bar code scanner” includes scanning “bar codes.” Some “bar code scanners” may even recognize “bar codes.” Applicants respectfully note, however, that Applicants’ claims 36 and 70 pertain to recognition of characters. Thus, the response by the Office to Applicants’ arguments does not even address the language of claims 36 and 70, let alone address the substance of Applicants’ arguments, as required by M.P.E.P. §707.07 and 37 C.F.R. §1.104.

Applicants assume that the Office intended to state “Examiner respectfully notes that the functionalities of a bar code scanner, as well known in the art, include recognizing [characters].”

Applicants respectfully submit that the Office again fails to cite to any authority or provide any other means to support the perceived assertion that “the functionalities of a bar code scanner, as well known in the art, include recognizing [characters].” Applicants respectfully disagree with such an assertion.

To the extent that the Office is asserting inherency, Applicants once again respectfully remind the Office that according to M.P.E.P. §2112, Sec. IV, page 2100-47, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (emphasis added)

The M.P.E.P. also states, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).” MPEP §2112, Sec. IV, 2100-48 (emphasis added).

The Office has again failed to show that the "bar code scanner" of Meyerson necessarily performs character recognition. Applicants respectfully submit that the Office has not cited to any authority, let alone one that teaches that a "bar code" is a "character," or that a "bar code scanner" necessarily performs "character recognition." Further, the Office has not provided any explanation or the "explicit analysis" required by M.P.E.P. §2142 to explain the reasoning on which the Office bases such an assertion. Therefore, Applicants respectfully submit that the Office has not shown that a "bar code scanner" necessarily performs character recognition, and therefore has not met the requirements for a rejection based on inherency.

To the extent that the Office is asserting "Official Notice," Applicants respectfully challenge the perceived assertion of Official Notice. The M.P.E.P. clearly recognizes that "[i]t is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697" M.P.E.P. §2144.03(A).

Applicants believe that the Office has performed a "thorough search" of the prior art as part of its obligation under 37 C.F.R. §1.104. Applicants respectfully submit that, if the assertion that it is well known that "the functionalities of a bar code scanner" include "recognizing [characters]" was in fact true, the "thorough search" would have revealed prior art supporting such an assertion. The Office would then be obligated to present evidence of any such prior art. The fact that the Office has failed to identify any such prior art leaves the Applicants to conclude that no such prior art exists. If the perceived assertion of Official Notice is instead based upon the personal knowledge of the Examiner, the Examiner must provide an affidavit attesting to the nature of such personal knowledge. See 37 C.F.R. §1.104. Otherwise, the rejection must be withdrawn.

The Advisory Action mailed August 31, 2010 also fails to identify any support for the unsupported assertion at page 2 that "[a] bar code a [sic] symbol that contains information thus it can be viewed as a character." Applicants respectfully disagree. A

"bar code" is not a character, and the Office has not shown any support from any authority for this statement.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has failed to show that Meyerson at column 9, line 28, or any other art, renders Applicants' claims 36 and 70 unpatentable. Because the Office cites only Meyerson and does not assert that the remaining art provides any support for the rejection, Applicants respectfully submit that the Office has failed to show that the proposed combination of references renders claims 36 and 70 unpatentable. Therefore, Applicants respectfully submit that claims 36 and 70 are independently allowable over the cited art.

With regard to claims 41 and 42, Applicants respectfully submit that claim 41 recites, "[t]he method of claim 37 wherein the processing comprises identifying the type of information in the image." Claim 42 depends from claim 41. Applicants respectfully submit that the Office action rejects claim 41 at page 4, stating, in its entirety:

Meyerson et al. further discloses that the image is text, handwriting or a picture (text, handwriting or pictures can all be considered as a form of image, in one form or another; and the process in which image is being captured is viewed as the same function as information in the image is being identified).

Initially, Applicants respectfully note that the Office cites only Meyerson, but then fails to provide any identification of any text or figures from Meyerson, or any of the remaining cited prior art, as support for the rejection. The rejection is nothing more than a conclusory statement that "Meyerson ... discloses that the image is text, handwriting or a picture...." Applicants respectfully submit that Applicants' claim 41 requires that the "processing" of claim 37 identify the type of information in the image. Any alleged teaching (not identified) that Meyerson, Morris, and/or Kotani may disclose that the information in the image may be "text, handwriting, or a picture" does not teach, suggest, or disclose "processing" that "identifies the type of information in an image," as

recited by claim 41. Amended dependent claim 42 further defines that the “processing” is able to specifically identify the image as text, handwriting, or a picture. Applicants respectfully submit that the Office has failed to show where Meyerson, Morris, and/or Kotani, taken alone or in any combination, teaches, suggests, or discloses “processing” that actually identifies the type of information in an image, as required by claim 41. Therefore, the Office has not established a *prima facie* case of obviousness with respect to claim 41, or any claims that depend therefrom, and has not shown that the proposed combination of references renders claims 41 and 42 unpatentable. Applicants respectfully submit that claims 41 and 42 are therefore independently allowable over the cited art.

The Advisory Action of August 31, 2010 states, at page 2, “[b]ecause claims 41 and 42 are dependent from claim 37, the same rejection from claim 37 applies to claim [sic] 41 and 42.” Applicants respectfully submit that the perceived assertion that claims 41 and 42 are somehow unpatentable simply because claim 37, from which they depend, is allegedly unpatentable, is an error. The Office must set forth a *prima facie* case that the features of claims 41 and 42 are unpatentable. The Office states that “Meyerson et al. further discloses that the image is text, handwriting or a picture (text, handwriting or pictures can all be considered as a form of image, in one form or another, and the process in which the image is being captured is viewed as the same function as information in the image is being identified.” See Office action of April 14, 2010 at page 4. Applicants respectfully submit, however, that the Office has not cited to any teachings in Meyerson, or any other reference, showing support for the rejection of claims 41 and 42, and more specifically, for the basis upon which the Office states that “the process in which the image is being captured is viewed as the same function as information in the image is being identified.” For example, a television camera captures an image, but does not specifically identify the image as text, handwriting, or a picture. Applicants respectfully submit that claims 41 and 42 are not rendered unpatentable because the claim from which they depend, claim 37, is allegedly unpatentable.

Based at least upon the above, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to at least claims 22, 28, 31-33, 36, 37, 45, 47, 49, 56, 62, 65-67, and 70 in accordance with MPEP §2142, and has therefore failed to show that the proposed combination of Meyerson, Morris, and Kotani renders Applicants claims 22, 28, 31-33, 36, 37, 45, 47, 49, 56, 62, 65-67, and 70 unpatentable. Therefore, Applicants respectfully submit that the rejection of independent claims 22, 37, 49, and 56, and their respective dependent claims under 35 U.S.C. §103(a), cannot be maintained.

Therefore, for at least the reasons set forth above, Applicants believe that claims 22, 28, 31-33, 36, 37, 45, 47, 49, 56, 62, 65-67, and 70 are allowable. Applicants respectfully submit that claims 23-36, 38-48, 50-55, and 57-70 depend, respectively, from allowable independent claims 22, 37, 49, and 56. Because claims 23-36, 38-48, 50-55, and 57-70 depend from claims 22, 37, 49, and 56, Applicants respectfully submit that claims 23-36, 38-48, 50-55, and 57-70 are also allowable, for at least the same reasons. In addition, Applicants respectfully submit that claims 36, 41, 42, and 70 have been shown to be independently allowable. Therefore, Applicants respectfully request that the rejection of claims 22-70 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Newly Added Claims

Applicants have added new dependent claims 71-104 that depend from independent claims 22, 37, 49, and 56, which have been shown to be allowable. Applicants respectfully submit that support for claims 71-104 may be found, for example, at pages 158, 194-195, 216, 218, 234-236, 239-241, 243-245, and 259-261, and at FIGs. 28a, 29a, 29b, 31, 46b, 49a, 49b, 49c, 55a, and 60 of the Application. Applicants respectfully submit that these amendments do not add new matter, and that new claims 71-104 are allowable for at least the same reasons set forth above with respect to the rejections of independent claims 22, 37, 49, and 56.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim). An early Office Action on the merits and allowance of claims 22-103 is respectfully requested.

Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above. Applicants respectfully request that Examiner contact the undersigned at the number shown below, should the Examiner have any questions or if Applicants can be of any assistance.

The Commissioner is hereby authorized to charge any fees required by this submission, or to refund any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

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